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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/980,831 | 12/06/2001 | Byeong-Seok Oh | 078134-0105 | 8790 |

22428 7590 03/22/2005

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER


LE, KHANH H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|-------------------------------|---------------------------------|--|
|  Office Action Summary | Application No. 09/980,831 | Applicant(s) OH, BYEONG-SEOK | |
| | Examiner Khanh H. Le | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/06/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/11/02</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is responsive to the Applicants' original application. Claims 1-15 are pending in the current application. Claims 1 and 9 are the independent claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-5, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan, US 5,721,827 A, herein Logan.

As to claims 1 and 9, Logan discloses

A multimedia content providing service method and system for providing a multimedia content selected by a user through a communication network comprising steps of:

displaying content information on available multimedia contents (see at least Figs. 2-4 and associated text);

asking said user if said user will watch at least one of advertisement contents besides at least one of said available multimedia contents which said user has selected to watch (see at least col 27 l. 3-6, Fig. 5 and associated text; col 9 l. 50 – col 10 l. 6; col. 8 line 42 to col. 9 line 11);

discounting price of said selected at least one of multimedia contents in case said user answers that said user will watch at least one of said advertisement contents (abstract) ;

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retrieving said selected at least one of multimedia contents from said storage device; retrieving at least one of said advertisement contents in case said user answers that said user will watch at least one of said advertisement contents (abstract; col. 8 line 42 to col. 9 line 11; col 4 l. 2-8; col 26 l. 53-59); and

providing said selected at least one of multimedia contents and/or at least one of said advertisement contents to said user through said communication network (see at least Figs. 2-4 and associated text).

As to claim 4. Logan discloses an information communication control unit for sending and/or receiving information between said system and said user (see Figs. 2-4 and associated text).

As to claims 5, 12 (dependent on claims 1, 9 respectively) Logan discloses displaying information on said at least one of advertisement contents in order for said user to select at least one of said advertisement contents to watch in case said user has answered that said user will watch at least one of said advertisement contents (see Figs. 2-4 and associated text).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan.

As to claims 6, 13 (dependent on claims 1, 9 respectively) Logan does not specifically disclose, instead of said step of discounting price of said selected at least one of multimedia contents, giving a predetermined incentive to aid user in case said user answers that said user will watch at least one of said advertisement contents.

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However, Official Notice is taken that it is well-known to replace a discount with a predetermined incentive as these are rewards art-recognized equivalents. Thus, it would have been obvious to one skilled in the art at the time the invention was made to substitute the Logan's discounts with a predetermined incentive for the above stated reason.

6. Claims 2-3,7-8, 10-11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Deaton, US 6611811 B1, herein Deaton.

As to claims 2, 10 (dependent on claims 1, 9 respectively) and as to claims 7, 14 (dependent on claims 6, 13 respectively) Logan teaches more subsidies per more ads experienced (see at least col. 26) but does not specifically disclose varying the discount rates or adjusting the quantity of the predetermined incentive with the number of advertisements the user agrees to watch.

However, Deaton teaches economic differentiation which refers to providing an incentive based on the value of a particular customer to a given store. Deaton teaches providing different rewards to encourage certain specific behaviors of certain specific customers, such as varying discounts rates or providing a higher incentive once a specific performance threshold is reached (see e.g. FIG. 64A, FIGS. 19-21 and FIGS. 49-51, and associated text, about a process and system for providing discounts to customers at variable rates depending upon the amount the customer purchases in a given transaction.)

It would have been obvious to one skilled in the art at the time the invention was made to add Deaton's method of increasing the benefits (higher discount rates, or higher incentives) to the Logan situation of providing subsidies for ads watched, by varying the discount rate or the quantity of the incentive with the number of said advertisements watched to encourage the desired behavior, as taught by Deaton.

As to claims 3, 11 (dependent on claims 1, 9 respectively), and as to claims 8, 15 (dependent on claims 6, 13 respectively).

Logan teaches the subsidy is given only if a certain actual playing time of the ad is achieved (see at least columns 25-26) but does not disclose wherein the price discount rate or the quality and/or quantity of the predetermined incentive are adjusted according to the playing time of at least one of said advertisements said user agrees to watch.

However, Deaton teaches adjusting the discount rates or the quantity of a predetermined incentive per performance thresholds achieved. It would have been obvious to one skilled in the art at the time the invention was made to add to Logan's teaching of ad playing time as a performance criterion, Deaton's method of adjusting the discount rates or the quantity of the

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incentive per performance thresholds achieved, to arrive at the instant claims, as another method to encourage the behavior desired, increased experience of the ad.

Conclusion

7. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

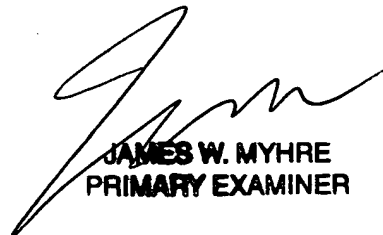
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in service until the move). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

March 09, 2005

KHL

KHL


JAMES W. MYHRE
PRIMARY EXAMINER